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EXAMINER

NGUYEN, DAVID Q

ART UNIT PAPER NUMBER

2681

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,553

Applicant(s)

WALSH, PATRICK JAY

Examiner

David Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 19, 21 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 20 and 22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. The inventions are distinct, each from the other because of the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12,19,21, and 23-25, drawn to allowing the remote source to know either an identity or a location of the wireless communication device at **a wireless communication network**, classified in class 455, subclass 408.
- II. Claims 20 and 22, drawn to drawn to allowing a remote source to know either an identity or a location of a wireless communication device at **the wireless communication device**, classified in class 455, subclass 407.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as “the wireless communication device”. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Scott W. Brim on 09/07/05 a provisional election was made without traverse to prosecute the invention of group I, claims 1-12,19,21, and 23-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20 and 22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Response to Arguments

2. Applicant's arguments filed 08/11/05 have been fully considered but they are not persuasive.

In response to applicant's arguments, Applicants argue: "Johansson fails to disclose a system or a method that prohibits a device from knowing **both an identifier and a location** of a wireless communication device".

Examiner respectfully disagrees because Johanson only discloses prohibiting a device from knowing **a location** of a wireless communication device. Johanson never mentions or disclose prohibiting a device from knowing **both an identifier and a location** of a wireless communication device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Johansson et al. (US 6,442,391).

Regarding claims 1 and 19, Johansson et al. discloses a method for providing privacy management for a wireless communication device, the method comprising the steps of: establishing rules of communication between the wireless communication device and a remote source (see col. 2, lines 37-44); and managing communications between the wireless

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communication device and the remote source in response to establish the rules of communication to: allow the remote source to know either an identity or a location of the wireless communication device (see col. 5, lines 50 to col. 6, line 2 and fig. 4); and prohibit the remote source from knowing both the identity and location of the wireless communication device (see col. 5, lines 50 to col. 6, line 2 and fig. 4; Johanson only discloses prohibiting a device from knowing **a location** of a wireless communication device), in response to determining the wireless approves of the remote source (see col. 5, lines 50 to col. 6, line 2 and fig. 4), and prohibit the location of the wireless communication device from being known to the remote source in response to determining the wireless device does not approve of the remote source (see col. 6, lines 7-21 and fig. 4).

Regarding claim 2, Johansson et al. also discloses wherein the step of managing further comprising:

receiving a request for location information associated with the wireless communication device from the remote source (see step B1 in Fig. 5); determining whether or not the wireless communication device approves of the remote source in response to receiving the request for location information (see steps C2-C5 in fig. 5); sending the location information to the remote source in response to determining that the wireless communication device approves of the remote source (see step C6-C8 in Fig. 5)

Regarding claims 3, Johansson et al. also discloses wherein the remote source is a location privacy manager (for instance, a firm of haulage contractor-see col. 7, lines 31-744), the wireless communication device approves of the location privacy manager when the wireless communication device is registered to operate with the location privacy manager, and the

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wireless communication device does not approve of the location privacy manager when the wireless communication device is not registered to operate with the location privacy manager (see step C2 in fig. 5).

Regarding claim 4, Johansson et al. also discloses wherein the remote source is a location-enabled service (for instance, a service provider-see col. 9, lines 21-27), the wireless communication device approves of the location-enabled service when the wireless communication device accepts an identity of the location-enabled service, and wherein the wireless communication device does not approve of the location-enabled service when the wireless communication device does not accept the identity of the location-enabled service (see col. 9, line 28 through col. 10 line, also see steps E3-E4 in fig. 6).

Regarding claim 5, Johansson et al. also discloses wherein a wireless communication device manages communications between the wireless communications device and the remote source (see col. 11, lines 42-67).

Regarding claim 21, Johansson et al. discloses a wireless communication network comprising: an antenna for communicating radio frequency signals over a radio frequency communication channel between the wireless communication network and a wireless communication device (fig. 1); a receiver, coupled to the antenna, for receiving the radio frequency signals from the wireless communication device (inherent in GSM mobile communication system); a transmitter, coupled to the antenna, for transmitting the radio frequency signals to the wireless communication device (inherent in GSM mobile communication system); a communication switch, coupled to the transmitter and the receiver, for routing information communicated over radio frequency communication channel (inherent in

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GSM mobile communication system; MSC in fig. 1); a memory device for storing rules of communication between the wireless communication device and a remote source (fig. 1; HLR and VLR; see col. 8, lines 4-22); a location privacy manager interface, coupled to the remote source, for communicating signals between the wireless communication network and the remote source (see fig. 1; MPC and A2); and a controller, coupled to the communication switch, the memory device and the location privacy manager interface, for managing communications between the wireless communication device and the remote source in response to the rules of communication to: allow the remote source to know either an identity or a location of the wireless communication device, and prohibit the remote source from knowing both the identity and location of the wireless communication device (see col. 5, lines 50 to col. 6, line 2 and fig. 4; Johanson only discloses prohibiting a device from knowing **a location** of a wireless communication device), in response to determining the wireless communication device approves of the remote source (see col. 5, lines 50 to col. 6, line 2 and fig. 4) and (b) prohibit the location of the wireless communication device from being known to the remote source in response to determining the wireless communication device does not approve of the remote source (fig. 1 and col. 5, line 40 to col. 7, line 45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 6-12, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kingdon et al. (US 6,138,003) in view of Johansson et al. (US 6,442,391).

Regarding claims 6, 23 and 25, Kingdon discloses a method for providing privacy management for a wireless communication device, the method comprising the steps of:

establishing rules of communication between the wireless communication device and a remote source (280 in fig. 2); and managing communications between the wireless communication device and the remote source so that **at least one of the following acts** occurs responsive to the step of establishing the rules of communication: (a) allowing the remote source to know one but not both of an identity and a location of the wireless communication device and (b) prohibiting the location of the wireless communication device from being known to the remote source (see col. 4, line 54 through col. 5, line 47);

wherein the rules of communication device shall only communicate with the remote source having an acceptable identity (step 310 in fig. 3); and

wherein the step of managing further comprises:

receiving a request for location information associated with the wireless communication device from the remote source responsive to the remote source being pushed to the wireless communication device by the remote source (see col. 6, lines 10-15);

determining whether or not the wireless communication device approves of the remote source in response to the step of receiving the request for location information (see step 310 in fig. 3);

sending a request for the location information to the BTS 9220) currently serving the wireless communication device in response to determining that the identity of the remote source

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is acceptable to the wireless communication device (see step 398 in fig. 3 and steps 510-520 in fig. 5, see col. 6, lines 48-67); receiving the location information from the wireless communication device in response to the step of sending the request for location information to the wireless communication device (see step 525 in fig. 5, see col. 6, lines 65-67); sending the location information to the remote source responsive to the step of receiving the location information from the wireless communication device (see step 580 in fig. 5); and rejecting the request from the remote source in response to the step of determining that the wireless communication device does not approve of the remote source (see step 320 in fig. 3).

However, Kingdon fails to recite that the request for location information is sent directly to the wireless communication device and receiving the location information directly from the wireless communication device. Instead, Kingdon discloses using timing advance values and a triangulation algorithm (see col. 7, lines 31-39).

In an analogous art, Johansson discloses sending a location request to and receiving location information from a wireless communication device. The wireless communication device determines its location via GPS (see col. 1 lines 24-35 and col. 12 lines 17-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to equip the wireless communication device of Kingdon with a GPS terminal, as taught by Johansson, instead of using timing advance values. One of ordinary skill in the art would have been motivated to make this modification because including a GPS terminal would enhance the capabilities of the wireless communication device.

Regarding claim 7, the method also discloses wherein the remote source is a location privacy manager (for instance, a firm of haulage contractor-see col. 7, lines 31-744 of Johansson

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et al), wherein the wireless communication device approves of the location privacy manager when the wireless communication device is registered to operate with the location privacy manager, and wherein the wireless communication device does not approve of the location privacy manager when the wireless communication device is not registered to operate with the location privacy manager (see step C2 in fig. 5 Johansson et al).

Regarding claim 8, the method also discloses wherein the remote source is a location-enabled service (for instance, a service provider-see col. 9, lines 21-27 Johansson et al), wherein the wireless communication device approves of the location-enabled service when the wireless communication device accepts an identity of the location-enabled service, and wherein the wireless communication device does not approve of the location-enabled service when the wireless communication device does not accept the identity of the location-enabled service (see col. 9, line 28 through col. 10 line, also see steps E3-E4 in fig. 6 Johansson et al).

Regarding claims 9 and 24, the method of Kingdon in view of Johansson et al. also at least a wireless communication network and a location privacy manager manages communications between the wireless communication device and the remote source (MPC 270 in fig. 2 of Kingdon)

Regarding claim 10, the method also discloses the wireless communication device establish the rules of communication and manages the communication between the wireless communication device and the remote source (see col. 11, lines 42-67 Johansson et al.)

Regarding claim 11, the method also discloses the steps of establishing and managing are performed by a wireless communication network establish the rules of communication and

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manages the communication between the wireless communication device and the remote source (fig. 2 of Kingdon).

Regarding claim 12, the method of Kingdon in view of Johansson et al. also discloses the a location privacy manager establish the rules of communication and manages the communication between the wireless communication device and the remote source (fig. 2 of Kingdon).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q. Nguyen whose telephone number is 571-272-7844. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH H. FEILD can be reached on (571)272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Nguyen


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER